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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,195	08/08/2003	Atsushi Arai	114726-005	4106
24573	7590	12/30/2004	EXAMINER	
BELL, BOYD & LLOYD, LLC PO BOX 1135 CHICAGO, IL 60690-1135			BRITTAIN, JAMES R	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/637,195

Applicant(s)

ARAI ET AL.

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08272004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 16 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on March 12, 2004.

Drawings

The drawings were received on September 13, 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation “the decorative member enables to be formed variously, while the intermediate portion is formed in a fixed shape” (claim 3, lines 2-3) is vague, unclear and does not particularly point out the subject matter. There are no metes and bounds within the claim to serve notice to one reading the claim as to what the structure is so as to know what is covered and what is not covered. The limitation “and in a certain and common sectional shape along a direction” (claim 4, line 3) is vague and does not particularly point out the subject matter. There are no metes and bounds within the claim to serve notice to one reading the claim as to what the structure is so as to know what is covered and what is not covered. The limitation “the resin cover-molded around the decorative member which enables to be formed variously is in a fixed

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shape regardless of any shape of the decorative member” (claim 5, lines 2-3) is vague, unclear and does not particularly point out the subject matter. There are no metes and bounds within the claim to serve notice to one reading the claim as to what the structure is so as to know what is covered and what is not covered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horita et al. (US 5181298) in view of Minato (US 5771546) and Dubost (FR 2665346).

Horita et al. (figure 6) teaches pull tab structure for a slide fastener slider, comprising a core member 10 formed by integrally joining, through an intermediate portion, a slider body coupling member and an extending member 14 with a translucent tortoiseshell member 20 (col. 5, lines 14-15, 24) secured around the extending member 14 by adhesive. In column 5, line 24 Horita et al. indicate that instead of the pull tab 20 being wood, it can be tortoiseshell and this is a direct indication that the embodiment of figure 6 can have a tortoiseshell pull tab body. By being translucent the cover member 20 permits light to pass therethrough and the outline of the extending member could be seen and thereby be considered decorative. As applicant discloses the use of translucent covers, this is a sufficient teaching of a material that can be seen through. The difference is that the tortoiseshell member 20 is not cover-molded and the extending

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member 14 cannot be easily seen. However, Minato (figures 6, 7, 9, 12) teaches that it is desirable to embed decorative elements 12 of various designs (col. 5, line 34) into the pull tab and that the pull tab need not be semi-transparent but can be transparent (col. 5, line 49) thereby providing the advantage of more easily seeing the embedded decorative element and Dubost (figures 1-3) teaches typical decorative utensil handle structure with a transparent cover 3 molded to the decorative core 2 so as to be more aesthetically pleasing. As increasing the decorative appeal of the pull tab is inherently desirable, it would have been obvious to modify the pull tab of Horita et al. such that the cover material is transparent rather than translucent in view of Minato teaching in the pull tab art that it is desirable to have decorative elements not just embedded in a semi-transparent material, but also a transparent material so as to better view the covered material and to further cover-mold the decoration would have been obvious in view of Dubost (figures 1-3) teaches typical decorative utensil handle structure with a transparent cover 3 molded to the decorative core 2 so as to be more aesthetically pleasing. The teachings of Dubost are considered analogous art because it is a handle used on an implement for personal use similar to a slide fastener pull tab and the desirability of providing a pleasing aesthetic appearance is faced in the field of utensil use just as well as in the garment field. In each, the handle on the utensil or the pull tab, plays a small role in unifying a design or pattern in a larger whole, the table appearance or garment style. As to the remaining claims, these are directed to matters of aesthetics and Dubost teaches the use of an arrow-head shaped decorative member 2. The particular configuration is a matter of aesthetic choice based upon common designs and Minato suggests that various designs are desirable (col. 5, line 34) thereby rendering obvious applicant's choices.

Response to Arguments

Applicant's arguments filed September 13, 2004 have been fully considered but they are not persuasive. Applicant argues that the Horita et al. fails to indicate that there can be a decorative member inside the tortoiseshell body 20. However, in column 5, line 24 Horita et al. indicate that instead of the pull tab 20 being wood, it can be tortoiseshell and this is a direct indication that the embodiment of figure 6 can have a tortoiseshell pull tab body. Applicant alleges that the extending member of Horita et al. is not decorative. However, Minato (figures 6, 7, 9, 12) clearly shows that embedded linearly extending members can be considered a decorative shape thereby establishing the extending member of Horita et al. as being decorative. Applicant has shown no basis to discriminate between shapes that are decorative and those that are not, particularly in view of Minato showing an embedded linear extending member as being a decorative shape. Applicant argues Minato alone and not for its teaching as a secondary reference showing that it is desirable to embed decorative elements 12 of various designs (col. 5, line 34) into the pull tab and that the pull tab need not be semi-transparent but can be transparent (col. 5, line 49) thereby providing the advantage of more easily seeing the embedded decorative element. Applicant argues that the eating utensil handle of Dubost is non-analogous art. However, as indicated above, it is used to show typical decorative utensil handle structure with a transparent cover 3 molded to the decorative core 2 so as to be more aesthetically pleasing. The teachings of Dubost are considered analogous art because it is a handle used on an implement for personal use similar to a slide fastener pull tab and the desirability of providing a pleasing aesthetic appearance is faced in the field of utensil use just as well as in the garment field. In each, the handle on the utensil or the pull tab, plays a small role in unifying a design or pattern in

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a larger whole, the table appearance or garment style. Applicant further argues that there is no suggestion to combine the references. However, the suggestion is indicated in the above rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents of Soule (US D311158, figures 1, 5) and Johnson et al. (US D319804, figure 1) teach pertinent zipper pull tab structure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (703) 308-2222. The examiner can normally be reached on M-F 5:30-2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB